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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

021906.0003US1

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Signature

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name

Sara L. Geer

Application Number

09/753163

Filed

January 2, 2001

First Named Inventor

Robert Eisenman

Art Unit

2636

Examiner

Julie Lieu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 33,880

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

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Telephone number

July 14, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐

\*Total of 1 forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450**

Application No.: 09/753,163  
Applicant: Robert Eisenman  
Filing Date: January 2, 2001  
Art Unit: 2636  
Examiner: Julie Lieu  
Attorney Docket No.: 021906.0003US1

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This is a response to the Final Office Action mailed June 06, 2005. A Notice of Appeal accompanies this response.

Argument begins on page 2 of this paper.

## **ARGUMENT**

The final Office action dated May 23, 2005 rejected all pending claims (26-32) as being obvious over Johnson in view of Hoffman et al. The applicant disagrees.

To establish a prima facie case of obviousness, the Office must satisfy three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. [M.P.E.P. §2142]

### **A. The Johnson Reference was Misunderstood**

The examiner apparently failed to understand the Johnson reference. Johnson et al. discloses a car locator system having a handheld key fob which receives information with regard to the location of a vehicle, so as to facilitate finding of a vehicle parked in a large parking lot (see, e.g., the abstract, lines 7, 39, 53 of col. 1, lines 27, 57-59 of col. 2, lines 22-24 of col. 3). However, the examiner mistakenly maintains that Johnson discloses "... a device... that communicates with a plurality of satellites for determining a location of the device...." The fact is that the Johnson key fob merely receives information from the GPS system with regard to the location of a vehicle, it does not determine the location of the key fob! The remaining portion of the examiner's rejection was based on examiner's misunderstanding of the Johnson device, thus rejections to claims 25-32 should be withdrawn.

### **B. Lacking Motivation to Combine**

After it has been determined that certain prior art can be combined because it is analogous art, the Office must still show that the prior art contains a suggestion, i.e., a motivation, for the proposed combination. M.P.E.P. 2143.01. In other words, the prior art as a whole must contain something to suggest the "desirability," thus the obviousness, of making the combination. *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d

1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). Here, there is absolutely no teaching or suggestion to combine the Johnson device with Hoffman device. Johnson teaches a key fob that receives and displays location information on a nearby vehicle. Hoffman teaches a portable device that transmits location information to a distal dispatch station. Combining the two references does not make the Johnson device more desirable in locating a vehicle in a large parking lot. Likewise, combining the two references does not make the Hoffman device any more desirable for an individual in distress to initiate a signal for others to locate the individual.

In her rejections, the examiner has completely failed to properly point out a motivation or suggestion in the prior art to combine the specific elements of the currently claimed combination. Instead, the examiner merely reiterates her mantra of obviousness – that is just not sufficient.

**C. Failure To Acknowledge Express Elements In Applicant's Claims**

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

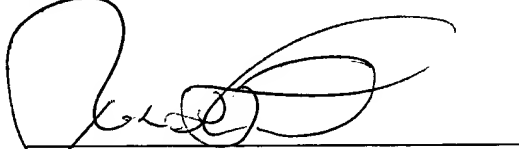
With respect to claim 26, there are at least three elements missing from Johnson -- the first and second triggers, and the inclusion of both types of triggers in a single remote control GPS unit for a car alarm. The examiner contends that it would be obvious to pull those missing elements from the prior art because they are conventional in the art. But those elements are not all in the prior art. Yes, a first trigger for a car alarm is old. And a second trigger for sending a warning to a distant location is old. But it is novel and non-obvious to combine them in a GPS unit.

Moreover, the examiner is missing the point. The applicant doesn't have the initial burden of proving non-obviousness. The Office has the initial burden of setting forth a *prima facie* case of obviousness, and to do that the Office must identify **specific** teachings, suggestions or motivations in the prior art for making the claimed combination. Merely pointing out that various elements by themselves are known in the prior art is insufficient. Nor is it sufficient to merely state that combination of the missing elements is obvious because their combination

## CONCLUSION

In its repeated obviousness rejections throughout the long prosecution history, the Office never once set forth a proper prima facie case of obviousness. Indeed, in its rush to reject the claims, the Office seems to have misrepresented or at least misunderstood its own main reference (Johnson). The rejections should be withdrawn.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. D. Fish', written over a horizontal line.

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Dated: July 14, 2005

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would be beneficial. If that were the standard nothing would ever be patentable. The missing elements, are neither taught nor suggested by Johnson or Hoffman, or any other cited references.

**D. Examiner's Conclusion was based on Hindsight**

The examiner's conclusion of obviousness was based on impermissible hindsight.

"Any judgment on obviousness," however, "is... necessarily a reconstruction based upon hindsight..." *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (emphasis added); *Radix Corp. v. Samuels*, 13 USPQ2d 1689, 1693 (D.D.C. 1989). As long as the judgment takes into account only knowledge that was within the level of ordinary skill at the time of the invention and does not include knowledge gleaned only from an applicant's disclosure, "such a reconstruction is proper." *McLaughlin*, 443 F.2d at 1395, 170 USPQ at 212 (emphasis added); *Radix Corp.*, 13 USPQ2d at 1693 (D.D.C. 1989).

The examiner contends that it would have been obvious to incorporate the Hoffman device into the Johnson device. Contrary to the examiner's contention, the Johnson device does not readily teach the combination of vehicle keyless entry remote control with a person locator within the same key chain for convenience. The Johnson device discloses a vehicle keyless entry remote control that receives information about the location of the vehicle and displays such information on the remote control. Therefore, the teaching, suggestion or motivation to combine the cited references were imparted **only** from the applicant's disclosure.